REMARKS

Claims 1-43 are presently pending in this application and have been subject to restriction as follows:

I. Claims 1, 3, 3, 6-8, 10, 11, 13-21, 23-25, 27-29, 31, 32, 34-36, 38, 39 and 41-43, drawn to a vector and host cell comprising, and a method of using a nucleic acid comprising a 3' splice region and a nucleic acid to be *trans*-spliced; and

II. Claims 2, 5, 7, 9, 12, 17, 19, 20, 24, 26, 28, 30, 33, 37, 40, 42 and 43, drawn to a vector and host cell comprising a 5' splice region and a nucleic acid to be *trans*-spliced.

In support of the present restriction requirement, the Examiner has alleged that the subject matter of the pending claims represent distinct inventions because:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. According to the Examiner, Invention I has separate utility such as the methods of exon tagging and identification of proteins expressed in a cell, as disclosed in the specification, which does not require the presence of the 5' splice site in the heterologous nucleic acid.

The requirement for restriction is respectfully traversed because there is clearly a structural and functional relationship between the claims of Group I and II. The claims of Groups I and II relate to compositions and methods for generating novel nucleic acid molecules.

The compositons and methods of the invention relate to pre-trans-splicing molecules (PTMs) which comprise (i) one or more target binding domains; (ii) a 3' splice region that includes a branch point pyrimidine tract and a 3' splice acceptor site; **AND/OR** (iii) a 5' splice donor site.

Applicants assert that whether the claimed PTM has a 3' splice region, a 5' splice region or both a 3' and 5' splice site, the PTMs functions to mediate *trans*-splicing reactions. Contrary to the Examiner's assertion, this holds true for exon tagging and identification of proteins expressed in a cell. For example, p.43 line 21 through p.44, line 5 of the specification discloses the use of PTMs having 3' splice regions or 5' splice regions for exon tagging. Additionally, p.45, lines 7-12 of the specification discloses the use of PTMs having 3' splice regions or 5' splice regions for identification of proteins expressed in a cell.

Moreover, Applicant's respectfully direct the Examiner's attention to U.S. Patent No:6,280,978 ("the '978 patent"), a patent to which the present application claims priority, attached herewith as Exhibit A. A review of the claims issued in the '978 patent demonstrates that the Patent and Trademark Office had previously determined that claims to compositions and methods relating to PTM molecules having (i) 3' splice regions; (ii) 5' splice regions; and (iii) both 3' and 5' splice regions were considered a single invention.

Finally, given the relationship between the subject matter encompassed by the pending claims of Groups I and II, Applicants assert that there would not be an undue search burden to examine the pending claims as a single group.

However, in order to be fully responsive to the requirement for restriction, Applicants elect, with traverse, the claimed vector and host cell of Group I comprising, and a

method of using a nucleic acid comprising a 3' splice region and a nucleic acid molecule to be *trans*-spliced. Withdrawal of the requirement for restriction and favorable consideration and allowance is earnestly solicited.

Respectfully submitted,

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